



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Confirmation Number: 5436

Kee-Hung LAI et al.

Attorney Docket: P69237US0

Serial No. 10/690,821

Group Art Unit: 2857

Filed: October 23, 2003

Examiner: Manuel L. BARBEE

For: METHOD AND INSTRUMENT FOR EVALUATING SUPPLY CHAIN  
PERFORMANCE IN TRANSPORT LOGISTICS

**APPEAL BRIEF UNDER 37 C.F.R. 1.192**

Mail Stop Appeal Brief -Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is an appeal from the Examiner's Final Rejection dated March 8, 2006 of Claims 1 – 9 and 11 – 12. A Notice of Appeal was filed on August 31, 2006, together with a Request for three-month extension of time.

**I. REAL PARTY IN INTEREST**

The real part in interest is The Hong Kong Polytechnic University by virtue of the assignment recorded at Reel/Frame 15101/981-982 in the this application on March 17, 2004.

**II. RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' representative and their assignee are not aware of any other appeals or interferences which will directly affect or be directly affected by or having a

bearing on the decision of the Board of Patent Appeals and Interferences (“Board”) in this appeal.

### **III. STATUS OF THE CLAIMS**

The appealed claims are Claims 1 – 9 and 11 – 12, which are currently pending in this application. Claim 10 was cancelled in a response filed on October 6, 2005. Claims 1 – 9 and 11 – 12 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly being based on a disclosure that is not enabling and not including into the claims the elements that are critical or essential to the practice of the invention. In addition, Claims 1 – 9 and 11 – 12 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, and being incomplete for omitting essential elements. A copy of the claims on appeal appears in the attached Appendix.

### **IV. STATUS OF AMENDMENT**

The pending claims were not amended in the Response to the Final Rejection filed on July 19, 2006.

### **V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Traditionally, the focus of supply chain performance measurement has been on process operations within the organizational boundaries of a firm. The present invention provide an evaluation instrument and method that measure the performance of other members in the supply chain, backward from the suppliers and forward to the customers, as well as the internal processes (see page 2, 6 – 11). As claimed in Claims 1 – 9 and 11 – 12, the instrument for measuring supply chain performance includes a plurality of items divided into three dimensions, which include the service effectiveness for shippers (SES), the service effectiveness for consignees (SEC) and the operations efficiency of the transport logistic providers (OE) (see Claims 1, 8, 9; page 3, lines 11 – 15 of the

specification). Using the instrument allows a user to measure and identify areas for specific improvement in the supply chain from the perspective of the transport logistics provider (see Abstract on page 19). The measurement of SES and/or SEC can be further divided into reliability and responsiveness aspects (see Claims 2, 6; and page 3, lines 17 – 19 of the specification; Fig. 1). The measurement of OE can be further divided into cost and assets aspects (see Claims 3, 7; and page 3, lines 21 – 22 of the specification; Fig. 1). These further-divided aspects are specified as measurement items such as those listed in Claims 1, 4, 5, 11, 12 (see page 8, lines 13 – 22 and Fig. 2). Claim 5 is directed to a method for evaluating supply chain performance in transport logistics using the instrument by evaluating various measurement items listed therein. The specification provide detailed description as well as drawings (Figs. 3 – 8) on the structure of the instrument as described above and how to use the instrument (see pages 9 – 16). The data collected according to the instrument are subject to validity and reliability tests, and tests under first-order and second-order models. According to the description of specification on page 14, lines 10 – 23, a user may evaluate the performance based on response to a single item or a higher-level abstract analysis.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Whether Claims 1 – 9 and 11 – 12 are properly rejected under 35 U.S.C. §112, first paragraph, because they are based on a disclosure that is not enabling and do not include into the claims the elements that are critical or essential to the practice of the invention?

Whether Claims 1 – 9 and 11 – 12 are properly rejected under 35 U.S.C. §112, second paragraph, because they are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, and being incomplete for omitting essential elements?

## **VII. ARGUMENT**

**Claims 1 – 9 and 11 – 12 Are Definite, Sufficiently Supported by The Specification and Include The Elements That Are Critical or Essential to The Practice of The Invention**

The final rejections of the application are based on enablement and indefiniteness requirements of 35 U.S.C. 112, first and second paragraphs. Especially, the Examiner pointed to the lack of critical structure of the measurement instrument in the claims. According to the U.S. patent law, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality (see M.P.E.P. 2164.08(c)). Because the three dimensions – SES, SEC and OE are included in the claims, the Examiner's rejection is improper.

It is respectfully submitted that the pending claims properly comply with the enablement requirement. It is note that the Examiner's rejection is directed to the allegation that there is no description regarding HOW to relate the responses to the questionnaire to the measured items, or how the measured items are used to evaluate the supply chain performance. More specifically, the Examiner alleged that the current specification does not teach the reader how to use the results obtained in the questionnaire to evaluate the supply chain performance.

Applicant respectfully submits that the 26 measured items are descriptive, and a person of ordinary skill in the related art of supply chain performance can immediately utilize the response to each of the items to evaluate the performance. How the performance is evaluated will be determined by the application environment, and the person who carried out the evaluation. For example, it is typical in a questionnaire to set a value of "1" to "5" for the level of satisfaction, with "1" representing "very satisfactory" and "5" representing "very poor". Of course, the person skilled in the art is allowed to switch the values, that is with "5" representing "very satisfactory" and "1" representing "very poor". It is also known that the level of satisfaction can be assigned with any values desired, for example, "1" to "100." The person skilled in the art can then use these values to evaluate the supply

chain performance according to the teachings on pages 9 – 16 of the specification. Therefore, the rejection based on failing to satisfy the enablement requirement is incorrect.

Applicant further submits that the questionnaire is, in fact, an enabling mechanism that makes it possible for users to evaluate their supply chain performance in the context of transport logistics. The tool, in the form of questionnaire, consists of both a method and an instrument, which has been “empirically validated” to form a self-diagnostic tool to measure supply chain performance in transport logistics (specified in the transport logistics context, not related to generic logistics or supply chain performance parameters). The 26 measurement items, in the form of questionnaire, are the enabling mechanism themselves for any person in transport logistics to use for evaluating transport logistics. The present invention is to offer a classification scheme of supply chain performance in transport logistics that consists of three dimensions, i.e., SES, OE and SEC, whereas each dimension consists of two sub-dimensions, and use the 26 validated questionnaire items as the instrument to evaluate the different dimensions and sub-dimensions of supply chain performance in logistics transport. The classification of supply chain performance in transport logistics at different dimension levels, together with the 26 validated questionnaire items, provides an enabling structure to deploy the 26 items for evaluating supply chain performance in transport logistics at different levels of abstraction of supply chain performance in transport logistics. The classification of the different dimensions of supply chain performance in transport logistics provides a structure for using the 26 questionnaire items as a self-diagnostic tool, i.e. a method and an instrument, for evaluating the different dimensions of SCP in transport logistics. It is respectfully submitted that a person of ordinary skill in the art is able to make and use the present invention as claimed based on the disclosure of the specification.

In addition, it is respectfully submitted that the pending claims particularly point out and distinctly claim the subject matter which applicant regards as the invention and no omitting essential element is omitted. More specifically, Claims 1 and 11 clearly indicates that “an instrument ... including a plurality of measurement items wherein said items are divided into at least the dimension of service effectiveness for shippers, service

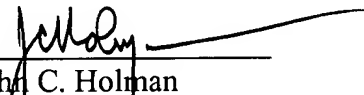
effectiveness for consignees and operations efficiency for transport logistics providers...". It is respectfully submits that the structure of the elements of the present invention is clear to a person of ordinary skill in the art of supply chain management. For example, the structure of the measurement items are divided according to the dimension of service effectiveness for shippers, service effectiveness for consignees and operations efficiency for transport logistics providers.

Therefore, the rejection under 35 U.S.C. § 112, first and second paragraphs, has been overcome. Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, first and second paragraphs, is respectfully requested.

Respectfully submitted,

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IN TRIPLICATE

Enclosed:

CLAIM APPENDIX  
EVIDENCE APPENDIX  
RELATED PROCEEDING APPENDIX

### **VIII. CLAIM APPENDIX**

Claim 1. (previously presented) An instrument for evaluating supply chain performance in transport logistics including a plurality of measurement items wherein said items are divided into at least the dimension of service effectiveness for shippers, service effectiveness for consignees and operations efficiency for transport logistics providers, wherein said plurality of measured items in the dimension of service effectiveness to shippers include:

- fulfilling promises to shippers;
- solving shippers' problem;
- performing services for shippers right the first time;
- providing services at the time promised to the shippers;
- keeping shippers' records accurately;
- informing shippers exactly when services will be performed;
- giving prompt services to shippers;
- willingness to help shippers; and
- timely response to shippers' requests.

Claim 2. (previously presented) The instrument for evaluating supply chain performance in transport logistics as claimed in claim 1 wherein at least one of said service effectiveness for shippers and/or said service effectiveness for consignees is further subdivided into reliability and responsiveness.

Claim 3. (previously presented) The instrument for evaluating supply chain performance in transport logistics as claimed in claim 1 wherein said operations efficiency is further divided into cost and asset aspects.

Claim 4. (previously presented) The instrument for evaluating supply chain performance in transport logistics as claimed in claim 1 wherein said plurality of measured items include one or more items substantially related to any of the following:

- fulfilling promises to shippers;
- solving shippers' problem;

- performing services for shippers right the first time;
- providing services at the time promised to the shippers;
- keeping shippers' records accurately;
- informing shippers exactly when services will be performed;
- giving prompt services to shippers;
- willingness to help shippers;
- timely response to shippers' requests;
- reducing order management costs;
- reducing costs associated with facilities/equipment/manpower used in providing the services;
- reducing warehousing costs;
- reducing transportation costs;
- reducing logistics administration costs;
- improving the rate of utilization of facilities/equipment/manpower in providing the services;
- improving the cash to cash cycle time;
- improving net asset turns;
- fulfilling promises to consignees;
- solving consignees' problems;
- performing services for consignees right the first time;
- providing services at the time promised to the consignees;
- keeping consignees' records accurately;
- informing consignees exactly when services will be performed;
- giving prompt services to consignees;
- willingness to help consignees; and
- timely response to consignees' requests.

Claim 5. (previously presented)      A method for evaluating supply chain performance in transport logistics comprising:

providing an instrument for evaluating supply chain performance in transport logistics including a plurality of measurement items wherein said items are divided into at



least the dimension of service effectiveness for shippers, service effectiveness for consignees and operations efficiency for transport logistics providers; and

evaluating performance based on an evaluation of performance of said measurement items in said instrument;

wherein said plurality of measured items in the dimension of service effectiveness to shippers include:

- fulfilling promises to shippers;
- solving shippers' problem;
- performing services for shippers right the first time;
- providing services at the time promised to the shippers;
- keeping shippers' records accurately;
- informing shippers exactly when services will be performed;
- giving prompt services to shippers;
- willingness to help shippers; and
- timely response to shippers' requests.

Claim 6. (previously presented) The instrument for evaluating supply chain performance in transport logistics as claimed in claim 2 wherein both said service effectiveness for shippers and said service effectiveness for consignees are further subdivided into reliability and responsiveness.

Claim 7. (previously presented) The instrument for evaluating supply chain performance in transport logistics as claimed in claim 6 wherein said operations efficiency is further divided into cost and asset aspects.

Claim 8. (previously presented) The instrument for evaluating supply chain performance in transport logistics as claimed in claim 1 wherein said instrument includes operations efficiency parameters and service effectiveness parameters for shipper, consignee and transport logistics provider.

Claim 9. (previously presented) The instrument for evaluating supply chain performance in transport logistics as claimed in claim 1 wherein performance is measured and evaluated on a supply chain-wide basis.

Claim 10. (cancelled)

Claim 11. (previously presented) An instrument for evaluating supply chain performance in transport logistics including a plurality of measurement items wherein said items are divided into at least the dimension of service effectiveness for shippers, service effectiveness for consignees and operations efficiency for transport logistics providers, wherein said plurality of measured items in the dimension of service effectiveness to consignees include:

- fulfilling promises to consignees;
- solving consignees' problems;
- performing services for consignees right the first time;
- providing services at the time promised to the consignees;
- keeping consignees' records accurately;
- informing consignees exactly when services will be performed;
- giving prompt services to consignees;
- willingness to help consignees; and
- timely response to consignees' requests.

Claim 12. (previously presented) The instrument for evaluating supply chain performance in transport logistics as claimed in claim 1 wherein said plurality of measured items in the dimension of operation efficiency for transport logistics providers include:

- reducing order management costs;
- reducing costs associated with facilities/equipment/manpower used in providing the services;
- reducing warehousing costs;
- reducing transportation costs;
- reducing logistics administration costs;

improving the rate of utilization of facilities/equipment/manpower in providing the services;

improving the cash to cash cycle time; and

improving net asset turns.

**IX. EVIDENCE APPENDIX**

There is no supporting evidence.

**X. RELATED PROCEEDING APPENDEX**

There are no related proceedings.